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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) LVIP:106US	
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	First Named Inventor Reinhard Lihl		
	Art Unit 3724	Examiner Carolyn T. Blake	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>51,990</u>		<u>[Signature]</u> Signature <u>C. Paul Maliszewski</u> Typed or printed name <u>716-626-1564</u> Telephone number <u>May 23, 2006</u> Date	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): LIHL, et al.

U.S. Patent Application No.: 10/604,135

For: ILLUMINATION DEVICE FOR
MICROTOMES AND
ULTRAMICROTOMES

Examiner: BLAKE, Carolyn T.

Group Art Unit: 3724

Confirmation No.: 1134

Customer No.: 24041

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C. Paul Malszewski
Registration No. 51,990

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Honorable Sir:

This Pre-Appeal Brief Request for Review is submitted in response to the Office Action of February 23, 2006 and the Advisory Action of May 15, 2006. Applicants hereby request review of the final rejection in the above-identified matter. A Notice of Appeal is concurrently filed this day for the above case.

Arguments are provided on page 2 of this paper.

Arguments

Rejection of Claims 1-4, 10, and 11 under 35 U.S.C. §112, first paragraph; Written Description

The Examiner has rejected Claims 1-4, 10 and 11 under 35 USC §112, first paragraph, as failing to comply with the written description requirement. The Examiner asserted on page 3, first paragraph of the Office Action dated February 23, 2006 (the Office Action) that it does not appear that Applicants were in possession of the claimed invention having three illumination systems at the same time in the same microtome, and they fail to show how to make each illumination system function over the other.

The Examiner appears to acknowledge that the three separate illumination systems are described in sufficient detail to meet the written description requirement for a microtome having one of the illumination systems, but that the disputed point is whether the application describes a microtome with three the illumination systems at once.

On pages 7-8 of the Reply, Applicants show that paragraph [0012] and Claim 1 offer explicit instruction that the microtome has the three illumination systems together. Paragraph [0012] states:

“The aforesaid object is achieved by way of a microtome or an ultramicrotome having a knife, a specimen arm movable relative to the knife, and at least one light source acting as a base-mounted illumination system, at least one light source acting as an incident illumination system for and at least one light source acting as an internal preparation illumination system, wherein all illumination systems illuminate a region around the preparation and the at least one light source is at least one light-emitting diode.”

The three illumination systems are clearly described as features that are installed on a single microtome. The use of the word and as an introduction to each illumination system of the microtome is indisputable support for the Applicants position that the three illumination systems are disposed on a single microtome. Had Applicants intended to describe a microtome with three illumination systems as alternative features, the word or would be used to join each illumination system. That is not the case here. In no place does the specification contradict the explicit instruction of paragraph [0012] that all three illumination systems are to be contained in a single microtome.

The Examiner stresses in the Advisory Action of May 15, 2006 that the foreign priority document of the instant application claims the three illumination systems in the alternative.

Applicants disagree with the Examiner's interpretation of those claims and the application and assert that the priority document is irrelevant in this case since Applicants are not relying on the priority document to overcome any of the pending rejections.

Accordingly, withdrawal of the rejection of Claim 1 under 35 USC §112, first paragraph, is appropriate and respectfully requested. Claims 2-4, 10 and 11 also comply with the written description requirement for the same reasons offered for the compliance of Claim 1 stated above, and the withdrawal of the rejection of Claims 2-4, 10 and 11 under USC §112, first paragraph, is appropriate and respectfully requested.

Rejection of claims 1-4, 10, and 11 under 35 U.S.C. 112, first paragraph; Enablement

The Examiner has rejected claims 1-4, 10, and 11 under 35 U.S.C. 112, first paragraph because the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.

On page 9, second paragraph of the Reply, Applicants stressed that the enablement requirement does not require that the information in the disclosure of an application contain details that would "enable one of ordinary skill in the art to make perfected, commercially viable embodiment absent a claim to that effect," but that the information provided in the disclosure be sufficient to inform those in the relevant art to make and use the claimed invention. MPEP §2164; *CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 68 USPQ2d 1940, 1944 (Fed. Cir. 2003). Applicants submit that the Examiner has incorrectly applied an enablement standard that is beyond what is required by statute. If applicants were required to show every feature known to one skilled in the art, patent applications would rival the size of most small town libraries. On page 8-10 of the Reply, Applicants show that there is ample support to enable one skilled in art to make the invention recited in Claims 1-4, 10 and 11. Applicants assert that the explicit instruction in paragraph [0012], coupled with the ample discussion of the individual illuminations systems in the specification, is sufficient disclosure to enable one of ordinary skill in the art to understand how to make and use a microtome with three illumination systems. Furthermore, certain information can be omitted from a written description since a patent disclosure need not teach information that is already presumed to be within the knowledge of a skilled artisan. See *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 68 U.S.P.Q. 2d (BNA) 1280, 1287 (Fed. Cir. 2003).

The Examiner disputes the capability of the three illumination systems to function over

each other. In arriving at this conclusion the Examiner appears to read into the claims a limitation that the microtome of Claims 1-4, 10 and 11 has three illuminations that are activated simultaneously. However, the rejected claims offer no indication that the three illumination systems are activated simultaneously. Claims 1-4, 10 and 11 are apparatus claims reciting a microtome with three separate illumination systems, not activation claims or method claims that recite illuminating the preparation area with the three illumination systems simultaneously. The activation of the three illumination systems simultaneously is not claimed, thus it does not have to be enabled.

Applicants respectfully request reversal of the rejection.

Rejection of Claims 1-4, 10, and 11 under 35 U.S.C. 112, second paragraph

The Examiner rejected Claims 1-4, 10, and 11 under 35 U.S.C. 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter considered to be the invention, i.e., "it is not clear how each of the illumination systems can be provided at the same time." Applicants respectfully submit that on pages 11-12 of the Reply, it is explained that Claims 1-4, 10 and 11 recite with clarity and precision the subject matter that is claimed, and that it is erroneous to hold the claims to be indefinite.

Rejection of Claims 1, 10, and 11 under 35 U.S.C. §103

The Examiner rejected Claims 1, 10, and 11 as being obvious in view of the teachings of German Patent Application No. DE 32 24 375 (Bilek), German Patent Application No. De 36 15 713 (Wolf), and U.S. Patent Application Publication No. 2003/0024368 (Fukuoka).

Arguments regarding Claim 1

Claim 1 recites at least one light source acting as a base-mounted illumination system, at least one light source acting as an incident illumination system, and at least one light source acting as an internal preparation illumination system wherein the illumination systems comprise LED's and are configured to illuminate the region around the preparation.

On page 13, second paragraph of the Reply, it shown that Bilek **does not teach an internal preparation system or an incident illumination system**.

On page 13, third paragraph of the Reply, it is shown that Wolf **does not teach an internal preparation illumination system or an incidental illumination system**. On page 13, fourth paragraph of the Reply, it is shown that Wolf fails to teach the use of an LED as a light source or illumination system. On page 4, of the Office Action, the Examiner stated that Wolf teaches an

illuminating system using a light-emitting diode (LED). On page 11-12 of the Reply, Applicants show that Wolf actually teaches using an LED as a position sensor, not as a light source. The Examiner has committed an error in facts by misrepresenting Wolf's proximity system.

On page 14, first paragraph of the Reply, it is shown that Fukuoka does not teach an internal preparation illumination system or an incidental illumination system.

Moreover, on page 14-15 of the Reply, it is shown that there is no motivation to combine the cited references.

The Examiner has failed to provide the elements necessary for a *prima facie* case of obviousness regarding Claim 1.

Applicants courteously request that the rejection be removed.

Arguments regarding Claims 10 and 11

Arguments regarding Claims 10 and 11 are presented on page 14 of the Reply and are substantially based on the arguments regarding Claim 1.

Rejection of Claims 2, 3, and 4 under 35 U.S.C. §103

Applicants' arguments regarding the rejections of Claims 2, 3, and 4 are presented on pages 14-15 of the Reply. The arguments are based on Claim 1 being patentable over the cited prior art, and the dependency of these claims from Claim 1.

Conclusion

For the reasons set forth above, Applicants respectfully submit that the present application is in condition for allowance, which action is courteously requested

Respectfully submitted,



C. Paul Maliszewski
Registration No. 51,990
CUSTOMER NO. 24041
Simpson & Simpson, PLLC
5555 Main Street
Williamsville, NY 14221-5406
Telephone No. 716-626-1564
Fax No. 716-626-0366

CPM/TGM
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